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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,292

08/27/2003

Scott Jacobs

130128

6679

7590

10/04/2005

Law Offices of John S. Munday
PO BOX 423
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EXAMINER

LEWIS, RALPH A

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,292

Applicant(s)

JACOBS ET AL.

Examiner

Ralph A. Lewis

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3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Objection to Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because applicants are declaring themselves to be the "sole" inventors when they are apparently "joint" inventors.

Objection to the Claims

Claims 2-4 and 8-10 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as his/her invention.

In claims 2-4, line 1, the "wherein element" language is confusing. The examiner suggest "wherein the element" or "wherein said element." To make it clear that "element" being referred to is the "element" of parent claim 1.

In claims 8-10, line 1, the "wherein junction means" language is confusing.

Rejections based on Prior Art

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg et al (US 4,413,979) in view of Jacobs et al (US 5,562,449).

Ginsburg et al disclose a dental tray for treating a patient's teeth comprised of a planar portion 12 for holding a treating material. The Ginsburg et al dental tray has an inner edge 16 and outer edge 18 (Figure 4). The inner edge 16 is a foldable portion and includes a groove 22 formed at the junction between to the planar portion and the inner edge 16 for guiding the folding. The outer edge 18 is folded to form a vertical wall with respect to the planar portion 12. In regard to claim 3, note the raised edge adjacent 22 that forms a "bead" structure. The Ginsburg et al dental tray meets all the limitations of the independent claims 1 and 7, with the exception of the "U-shaped" configuration.

Ginsburg et al discloses only half a U-shape. Jacobs et al, however, teaches that such dental trays commonly come in full u-shapes so that the entire upper or lower jaw may be treated. To have extended the Ginsburg et al tray to extend to a full U-shape so that an entire jaw of the patient may be treated would have been obvious to one of ordinary skill in the art. In regard to the EVA limitations of claims 6 and 12, Ginsburg et al disclose that the dental tray is thermoplastic that is softened by heat and then molded into its desired form, but does not disclose any particular thermoplastic material (column 3, lines 4-20). Jacobs et al teach the conventional use of the thermoplastic material EVA for such dental trays. To have selected conventional EVA for the thermoplastic material of Ginsburg et al would have been obvious to one of ordinary skill in the art in view of the teaching by Jacobs et al.

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Prior Art

Robinson (US 1,406,492), Neuwirth (US 2,696,046), Pos (US 3,064,354), Johnson et al (US 3,303,844), Neuwirth (US 3,765,092), Wagner (US 4,401,616), Oxman et al (US 5,026,278), Allred et al (US 6,860,736), Sagel et al (US 6,884,426), Cozzi (US 6,896,515) and Jacobs (US 6,896,518) are made of record.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R. Lewis
October 1, 2005



Ralph A. Lewis
Primary Examiner
Au3732